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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,987	05/25/2001	Iok-Hou Pang	1719F US	6461

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EXAMINER

FAY, ZOHREH A

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 02/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/856,987**

Applicant(s)  
**Pang**

Examiner  
**Zohreh Fay**

Art Unit  
**1614**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit:

Claims 1-14 are presented for examination.

1. The Information Disclosure Statement filed on May 25, 2001 has been received and entered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102 (b) as being anticipated by Takeda Chem Ind, Ltd (MT on PTO-1449). Takeda Chemical teaches the use of the claimed neurotrophic factor stimulator in a pharmaceutical formulation for the treatment of neuropathy and retinal diseases. The above reference makes clear that the claimed composition and the use thereof is old and well known.

Claim 3 and 6 are rejected under 35 U.S.C. 102 (b) as being anticipated by Graul et al. (IT on PTO-1449). Graul et al. teach the use of the claimed compound AIT-082 in a pharmaceutical formulation as a memory enhancing agent. The oral administration of claim 6 is also taught by the above reference. The recitation of a new use for an old composition does not render that composition new. See *In re Dillon*, 16, USPQ2nd 1897 at 1900 (CAFC 1990).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit:

Claims 7, 10, 12 and 14 are rejected under 35 U.S.C. 103 as being unpatentable over Rathone et al.

Rathone et al. Teach the use of the claimed neurotrophic factor, AIT-082 in a pharmaceutical formulation as a neuroprotective agent. See page 369, column 1 and the entire article. The above reference differs from the claimed invention in the use of such compound for protection of retina optic nerve and different routes of administration. It would have been obvious to a person skilled in the art to employ a well known neuroprotective agent for the protection of optic and retinal nerve head in the absence of evidence to the contrary. The use of different routes of administration is considered to be within the skill of the artisan. One skilled in the art would have been motivated to employ the teachings of the above reference, since it relates to the neuroprotective effect of the claimed compounds. Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed invention, and as such, claims 7-14 are properly rejected under 35 U.S.C. 103.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Fay whose telephone number is (703) 308-4604.

ZOHREN FAY  
PRIMARY EXAMINER  
GROUP 1200

